

of the connection pads 12 are located on the interior side of the windings for the antenna 11.

The Fidalgo patent does not disclose this claimed structure. Rather, as best seen in Figures 2 and 3 of the patent, the contact terminals 15 of the antenna are respectively located on *opposite* sides of the antenna turns. As such, they cannot be considered to be on a common side of the antenna turns, as recited in the claims. It is noted that the rejection does not address this feature, nor attempt to explain how the Fidalgo patent can be interpreted to disclose the claimed subject matter.

For at least this reason, therefore, claim 1 is not anticipated by the Fidalgo patent.

Furthermore, claim 1 recites the step of connecting at least one of the ends of the antenna to a respective one of the connection pads "by means of an insulating bridge disposed on a surface of said turns that is away from said support sheet." In rejecting claim 1, the Office Action refers to element 6 of the Fidalgo patent as an insulating bridge. This element is disclosed as a bonding layer in which the antenna 5 is embedded. Claim 1 recites that at least one of the ends of the antenna is connected to a respective one of the connection pads "by means of" the insulating bridge. The Office Action does not explain how the bonding layer 6 of the Fidalgo patent is being interpreted to disclose this claimed feature. Specifically, what role does the bonding layer 6 play in connecting the ends of the antenna to the contact terminals 15? It is respectfully submitted that the bonding layer 6 of the Fidalgo patent does not perform the same function as the insulating bridge recited in claim 1. For this additional reason, therefore, claim 1 is not anticipated by the Fidalgo patent.

Claim 2 recites that the insulating bridge is produced by covering the turns of the antenna with an insulating layer and "depositing on this insulating layer a conductive element so that one outer end of the antenna can be connected to one connection pad." In rejecting this claim, the Office Action refers to the Fidalgo patent at column 3, line 64 to column 4, line 5. This portion of the patent does not pertain to the connection of the ends of the antenna 5 to the contact terminals 15. Rather, it is directed to the structure of the electronic module 7, as best seen in Figure 5. The Office Action does not identify any structure in the Fidalgo patent that corresponds to the conductive element of claim 2. Specifically, it does not indicate where a conductive element is deposited on the bonding layer 6 that connects one outer end of the antenna to one connection pad. For this additional reason, therefore, claim 2 is not anticipated by the Fidalgo patent.

Claim 14 recites that the connection between the connection pads of the antenna and the module is formed by a solder with a low melting point. In rejecting this claim, the Office Action refers to the Fidalgo patent at column 6, lines 1-5. This portion of the patent is not directed to the connection of the module to the connection pads of the antenna. Rather, it relates to the fixing of the module in the bottom of the *cavity* 17, using various types of bonding materials such as adhesives. It does not disclose the use of a solder with a low melting point to connect the connection pads of the antenna to the module. For these additional reasons, therefore, the subject matter of claim 14 is not anticipated.

Claims 15-23 were rejected under 35 U.S.C. §103, on the contention that they are unpatentable over the Fidalgo patent. First, since the Fidalgo patent does not anticipate claims 1, 2 or 14, for the reasons presented above, it cannot be

interpreted to render the subject matter of claims 15-23 unpatentable. Furthermore, it is respectfully submitted that the Office Action does not establish a *prima facie* case of obviousness.

Claims 15-20 depend from claim 14, and recite specific compositions for the low melting point solder that connects the pads of the antenna to the module. The rejection of these claims is based upon the conclusory statement that it would be obvious to use these particular materials. However, it does not cite any references to support this conclusion. As set forth in MPEP §2143, one of the criteria for a *prima facie* case of obviousness is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." As further set forth in MPEP §2142, "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness" (emphasis added). The rejection does not identify *any* factual support for the conclusory statement. There are no applied references that teach or suggest the specific materials recited in each of claims 15-20. As noted above, the Fidalgo patent does not disclose the use of a solder with a low melting point to connect the connection pads of the antenna with the module. As such, it does not disclose a solder having the specific compositions recited in claims 15-20 for such a purpose. Since no other reference is cited in the rejection of claims 15-20, there is no showing of a prior art reference, or references, that teach or suggest all of the claim limitations, and hence no factual support for the conclusion.

Claims 21-23 depend from claim 1, and recite other materials for connecting the connection pads of the antenna and the module. The rejection of these claims is also based upon the conclusion that it would be obvious to choose the materials recited in these claims. Again, however, no reference is cited to support this

conclusion. For the same reasons as presented above, the Office Action fails to establish a *prima facie* case of obviousness, since it does not identify any prior art reference, or references, that teach or suggest all the claim limitations.

For at least these reasons, therefore, it is respectfully submitted that claims 1, 2 and 14-23 are patentably distinct from the Fidalgo patent. Furthermore, since generic claims 1 and 4 are allowable over that patent, it is respectfully submitted that dependent claims 6-12, 27 and 29 are also allowable, and should be reinstated with the claims currently under consideration.

Applicants also request reconsideration of the withdrawal of claims 45 and 46 from the application. The restriction of these claims is based on the contention that they are different from "the invention as originally claimed." However, claim 45 corresponds closely to claim 4 as originally presented. That claim was examined on its individual merits, and rejected on the basis of the Fidalgo patent discussed above. As such, there is no added burden on the examiner to continue with the examination of the subject matter. The mere fact that a recitation was added to claim 1, to further distinguish over the prior art, does not alter the scope of the subject matter that was originally examined, and should therefore continue to be examined.

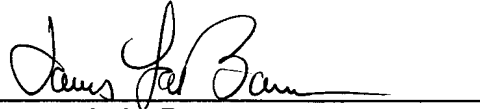
Accordingly, withdrawal of the restriction requirement as to claims 45 and 46, and examination of those claims in the present application, are respectfully requested.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:

A handwritten signature in black ink, appearing to read "James A. LaBarre", is written over a horizontal line.

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